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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/972,183

10/05/2001

Akihiko Toyoshima

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09/08/2004

ROGITZ & ASSOCIATES

750 B STREET

SUITE 3120

SAN DIEGO, CA 92101

EXAMINER

TORRES, MARCOS L

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 09/08/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,183

Applicant(s)

TOYOSHIMA, AKIHIKO

Examiner

Marcos L Torres

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on June 4, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "a user computer device" is not disclosed in the specification. It is noted

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that support is given for a PC or Laptop, however the term "user computer device" can be broadly interpreted as a calculator, etc. Therefore is deemed as new matter.

Claim Objections

4. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-10, 13-17 and 23-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yee.

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As to claim 1, Yee discloses a method for providing security data to a wireless module from a computer device with a visual display and an input device (see col. 3, line 65 – col. 4, line 57).

As to claim 2, Yee discloses a method for providing security code to a wireless module after it has been activated (see col. 7, line 64 – col. 8, line 14).

As to claim 3, Yee discloses issuing a security code through wireless transmission to the wireless module (see col. 7, line 64 – col. 9, line 35), and encrypting/decrypting security data (see col. 6, lines 11-27).

As to claims 4-5 and 14, Yee discloses storing a security code in the wireless module (see col. 9, lines 11-12).

As to claims 6-7, Yee discloses storing a security code in a peripheral device (see col. 9, lines 15-36).

As to claims 8, 15 and 17, Yee discloses providing a serial number to the wireless module (see col. 5, lines 38-39) and storing the serial number in a peripheral device (see col. 8, line 63 – col. 9, line 36).

As to claims 9-10 and 16, Yee discloses storing a security code in a peripheral device (see col. 9, lines 15-36) and in the wireless module (see col. 9, lines 11-12).

As to claim 13, Yee discloses a security system for a wireless module comprising a wireless module configured to receive security data and a peripheral device in communication with the wireless module, configured to receive security data and transmit peripheral data with a visual display and an input device (see col. 3, line 65 - col. 4, line 37; col. 8, line 42 – col. 9, line 36).

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As to claims 23-25, Yee discloses a wireless module comprising an electronic serial number (see col. 5, lines 38-39), said wireless module configured to be in electronic communication with at least one peripheral device with a visual display and an input device (see col. 4, lines 19-37), said wireless module further configured to store said electronic serial number to a peripheral device (see col. 8, line 63 – col. 9, line 36).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee in view of Helle.

As to claims 11 and 12, Yee discloses everything claimed as explained above except for notifying to the user of the peripheral device of said security code and requiring an input of the security code. Helle discloses notifying to the

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user of the peripheral device of said security code and requiring an input of the security code (see col. 3, lines 5-7). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Yee method for the simple purpose of enhanced security.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Tolopka U.S. Patent US006044349A

Any response to this Office Action should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 703-872-9306

For formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marcos L Torres
Examiner
Art Unit 2683

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WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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